

**REMARKS**

Claims 1-5 are pending in the above-identified application. Claims 1-5 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Inagaki* (U.S. Patent No. 6,765,246).

Applicant previously submitted a 37 C.F.R. §1.131 declaration attesting to the fact that the present invention was invented prior to the effective date of the *Inagaki* reference, which the Examiner found to be insufficient to establish diligence from a date prior to the date of reduction to practice of the *Inagaki* reference to either a constructive reduction to practice or an actual reduction to practice. In particular, the Examiner states that “there is no assertion of showing diligence during critical period between filing date of 8/21/200[2]<sup>1</sup> of *Inagaki* and the effective filing date 11/14/2002 of the instant invention.” Applicant respectfully disagrees.

The inventor, Mr. Hirata, expressly states that “between the date of conception and the filing of this Japanese Patent Application, my representatives and I worked reasonably hard and expeditiously to prepare, execute and file the Japanese Patent Application.” Hirata Declaration at ¶7. It is well established that “[t]he diligence of 35 U.S.C. 102(g) relates to reasonable ‘attorney-diligence’ and ‘engineering-diligence’ [citation omitted], which does not require that ‘an inventor or his attorney ... drop all other work and concentrate on the particular invention involved....’ [citation omitted].” MPEP §2138.06.

The pending application is owned by Sony Corporation. Since 1995, Sony has been among the top 10 corporations receiving the greatest number of U.S. patents. See Exh. A attached. It is clear that Sony has consistently had an extremely heavy caseload of patents and applications, including during the critical period in question.

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<sup>1</sup> Applicant notes that the filing date of *Inagaki* is 8/21/2002, and not 2005 as stated by the Examiner. Thus, the critical period during which Applicant must show diligence is just prior to 8/21/2002 (filing date of *Inagaki*) and 11/14/2002 (effective filing date of pending application).

"The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor." MPEP §2141. *See also Bey v. Kollonitsch*, 806 F.2d 1024 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.) Applicant respectfully submits that based on Sony's heavy patent caseload, it is not unreasonable for Sony to take 86 days (which is the length of the critical period at issue) to file a patent application. Moreover, 86 days is less than the usual 3-month shortened statutory period normally required for responses to Office Actions, which, by implementation of the rules, has been deemed a reasonable amount of time to respond to an office action -- a task which is typically less time consuming than preparation of an application.

Accordingly, Applicant requests withdrawal of the present rejection and submits that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

Dated: 1-5-06


  
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EXHIBIT A

## MEDIA ADVISORY

PTO 97-2

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USPTO ANNOUNCES LAST YEAR'S TOP PATENT EARNERS  
 IBM AGAIN TOPS THE LIST

ARLINGTON, VA -- The United States Patent and Trademark Office today announced its top patent recipients last year. The following organizations received the most patents for invention, i.e. utility patents, during the 1996 calendar year.

1996 Rank Rank)	1996 Patents (1995 Patents)	Organization	(1995
1 (1,383)	1,867	IBM	(1)
2 (1,087)	1,541	Canon	(2)
3 (1,012)	1,064	Motorola Inc.	(4)
4 (1,005)	1,043	NEC Corporation	(5)
5 (910)	963	Hitachi	(8)
6 (973)	934	Mitsubishi	(6)
7 (1,026)	923	U.S. GOVERNMENT	(3)
8 (969)	914	Toshiba Corporation	(7)
9 (724)	869	Fujitsu Limited	(13)
10 (754)	855	Sony	(12)
11 (854)	841	Matsushita Electric Ind. Co.	(9)

January 21, 1996

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PTO 98-1 / JANUARY 12, 1998



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**USPTO ANNOUNCES TOP PATENT EARNERS****IBM AGAIN TOPS THE LIST**

ARLINGTON, VA -- The United States Patent and Trademark Office (USPTO) today announced the top patent recipients for the 1997 calendar year. The USPTO received over 210,000 patent applications in 1997 and issued over 120,000 patents.

The following organizations received the most patents for inventions, i.e. utility patents.

1997 Rank	1997 Patents	Organization	1996 Rank	1996 Patents
1	1,724	IBM	1	1,867
2	1,381	Canon	2	1,541
3	1,095	NEC Corporation	4	1,043
4	1,058	Motorola Inc	3	1,064
5	935	U.S. GOVERNMENT	7	923
6	903	Fujitsu Limited	9	869
	903	Hitachi	5	963
8	892	Mitsubishi	6	934
9	862	Toshiba Corporation	8	914
10	859	Sony	10	855
11	795	Eastman Kodak Company	13	768

For the fifth straight year, IBM received more utility patents than any other non-Federal patenting organization. The top eleven patenting organizations consist of three U.S. corporations, seven Japanese corporations, and the U.S. government.

Patent information presented reflects patent ownership at patent grant and does not include changes in ownership which occur after the patent grant. Where more than one assignee (owner) exists, patents are attributed to the first-named assignee.

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**PRESS RELEASE JANUARY 8, 1999**

99-1

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**IBM REPEATS AT TOP OF PTO's ANNUAL LIST OF 10 ORGANIZATIONS RECEIVING MOST PATENTS**

**1998 Top Ten Corporations Receive 50% More Patents Than 1997's Top Ten.**

The United States Patent and Trademark Office (PTO) today announced the top ten private sector patent recipients for the 1998 calendar year. Listed below are the ten corporations receiving the most patents for inventions in 1998, along with their ranking last year. For the sixth straight year, IBM received more utility patents than any other private sector organization. The 1998 top ten corporations combined to receive 14,815 patents, a nearly 50% increase over the 10,162 patents granted to 1997's top ten.

(Final Rank) (Final Number of)

Rank in 1998 # of Patents Organization (in 1997) (Patents in 1997)

1 2,657 International Business Machines Corporation (1) (1,724)

2 1,928 Canon Kabushiki Kaisha (2) (1,381)

3 1,627 NEC Corporation (3) (1,095)

4 1,406 Motorola Inc. (4) (1,058)

5 1,316 Sony Corporation (10) (859)

6 1,304 Samsung Electronics Co., Ltd. (17) (582)

7 1,189 Fujitsu Limited (6) (903)

8 1,170 Toshiba Corporation (9) (862)

9 1,124 Eastman Kodak Company (11) (795)

10 1,094 Hitachi, Ltd. (6) (903)

The ten organizations with the most patents in 1998 represent three U.S. corporations, six Japanese corporations, and one corporation from the Republic of Korea. Agencies of the U.S. Government received a total of 1,017 patents in 1998, up from 935 in 1997.

**NOTE:** The listed patent counts for 1998 are preliminary counts which are subject to correction. The final listing of 1998 patent counts for the top ten should be available by early April. These statistics reflect patent ownership at the time the patent was granted and do not include changes in ownership which may have occurred after the patent was issued. Where there is more than one owner named on a patent, the patent is attributed to the first-named assignee.

-30-

**PRESS RELEASE #00-03**  
**JANUARY 11, 2000**

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## **IBM REPEATS AT TOP OF PTO's ANNUAL LIST OF 10 ORGANIZATIONS RECEIVING MOST PATENTS**

The United States Patent and Trademark Office (PTO) has announced the top ten private sector patent recipients for the 1999 calendar year. Listed below are the ten corporations receiving the most patents for inventions in 1999, along with their ranking last year. For the seventh straight year, IBM received more utility patents than any other private sector organization.

The ten organizations with the most patents in 1999 consist of three U.S. corporations, six Japanese corporations, and one corporation from the Republic of Korea.

Rank in 1999	# Patents in 1999	Organization
1	2,756	International Business Machines Corporation
2	1,842	NEC Corporation
3	1,795	Canon Kabushiki Kaisha
4	1,545	Samsung Electronics Co., Ltd.
5	1,409	Sony Corporation
6	1,200	Toshiba Corporation
7	1,193	Fujitsu Limited
8	1,192	Motorola Inc.
9	1,153	Lucent Technologies Inc.
10	1,054	Mitsubishi Denki Kabushiki Kaisha

**NOTE:** The listed patent counts for 1999 are preliminary counts which are subject to correction. The final listing of 1999 patent counts for the top ten should be available by early April. These statistics reflect patent ownership at the time the patent was granted and do not include changes in ownership which may have occurred after the patent was issued. Where there is more than one owner named on a patent, the patent is attributed to the first-named assignee.

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## PRESS RELEASE

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January 10, 2001  
#01-02

### USPTO RELEASES ANNUAL LIST OF 10 ORGANIZATIONS RECEIVING MOST PATENTS

*IBM repeats at top of list, while four U.S. corporations make the list this year.*

The United States Patent and Trademark Office (USPTO) has announced the top ten private sector patent recipients for the 2000 calendar year. Listed below are the ten corporations receiving the most patents for inventions in 2000, along with their ranking last year. For the eighth straight year, IBM received more utility patents than any other private sector organization.

For the year, the top ten patenting organizations consist of four U.S. corporations, five Japanese corporations, and one corporation from the Republic of Korea. One U.S. corporation has been added and one Japanese corporation has been dropped from the list. The U.S. Government received 920 utility patents for the year.

Preliminary Rank in 2000*	Preliminary # Patents in 2000*	Organization*	(Final Rank) (in 1999)	(Final Number of) (Patents in 1999)
1	2,886	International Business Machines Corporation	(1)	(2,756)
2	2,020	NEC Corporation	(2)	(1,842)
3	1,890	Canon Kabushiki Kaisha	(3)	(1,795)
4	1,441	Samsung Electronics Co., Ltd.	(4)	(1,545)
5	1,411	Lucent Technologies Inc.	(9)	(1,152)
6	1,385	Sony Corporation	(5)	(1,410)
7	1,304	Micron Technology, Inc.	(14)	(933)
8	1,232	Toshiba Corporation	(6)	(1,200)
9	1,196	Motorola Inc.	(7)	(1,192)
10	1,147	Fujitsu Limited	(7)	(1,192)
	920	U.S. GOVERNMENT		(983)

**\* The listed patent counts are preliminary counts which are subject to correction. The final listing of 2000 patent counts for the top patenting organizations should be available by early April.**

#### Please Note:

Patent information presented reflects patent ownership at patent grant and does not include ownership changes that occur after the patent grant. Where more than one assignee (owner) exists, patents are attributed to the first-named assignee.





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## PRESS RELEASE

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January 10, 2002

#02-01

## USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST PATENTS

IBM repeats at top of list

The United States Patent and Trademark Office (USPTO) announced the top 10 private sector patent recipients for the 2001 calendar year. Listed below are the 10 corporations receiving the most patents for invention in 2001, along with their ranking last year. For the ninth consecutive year, IBM received more patents than other private sector organization.

"I am proud that American corporations are leaders among U.S. patent holders," said James E. Rogan, U.S. Secretary of Commerce for Intellectual Property. "Patents promote technological progress and are a prelude to competitive free enterprise. Global confidence in the U.S. patent system confirms the strength of the American marketplace, and plays a key role in bringing an end to the recession."

### Top 10 Private Sector Patent Recipients for the 2001 Calendar Year

Preliminary Rank in 2001*	Preliminary * #Patents in 2001*	Organization*	(Final Rank) (in 2000)	(Final Number of) (Patents in 2000)
1	3,411	International Business Machines Corporation (IBM)	(1)	(2,886)
2	1,953	NEC Corporation	(2)	(2,021)
3	1,877	Canon Kabushiki Kaisha	(3)	(1,890)
4	1,643	Micron Technology, Inc.	(7)	(1,304)
5	1,450	Samsung Electronics Co., Ltd.	(4)	(1,441)
6	1,440	Matsushita Electrical Industrial Co., Ltd.	(11)	(1,137)
7	1,363	Sony Corporation	(6)	(1,385)
8	1,271	Hitachi, Ltd.	(13)	(1,036)
9	1,184	Mitsubishi. Denki Kabushiki Kaisha	(14)	(1,010)
10	1,166	Fujitsu Limited	(10)	(1,147)

\* The listed patent counts are preliminary counts, which are subject to correction. The final listing of patent counts for the top patenting organizations in 2001 should be available by early April 2002. This information reflects patent ownership at patent grant and does not include ownership changes that occur after patent grant. Where more than one assignee (owner) exists, patents are attributed to the first-named assignee.

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## PRESS RELEASE

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January 13, 2003

#03-01

## USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST U.S. PATENTS

American Innovation Leads the Field

The Department of Commerce's United States Patent and Trademark Office (USPTO) announced the 20 private sector patent recipients today. Listed below are the 10 corporations receiving the most patents for inventions in 2002, along with their 2001 ranking. For the tenth consecutive year, IBM received more patents than any other private sector organization.

In 2002, four U.S. corporations are included on the list of top ten patenting organizations, up from two in 2001. "American corporations continue to build America's technological strength worldwide," said James E. R. Under Secretary of Commerce for Intellectual Property. "Patents promote technological progress and stimulate economic growth and investment in commerce, creating jobs for millions of Americans."

### Top 10 Private Sector Patent Recipients for the 2002 Calendar Year

Preliminary Rank in 2002*	Preliminary # Patents in 2002*	Organization*	(Final Rank in 2001)	(Final Number of Patents in 2001)
1	3,288	International Business Machines Corporation	(1)	(3,411)
2	1,893	Canon Kabushiki Kaisha	(3)	(1,877)
3	1,833	Micron Technology, Inc.	(4)	(1,643)
4	1,821	NEC Corporation	(2)	(1,953)
5	1,602	Hitachi, Ltd	(8)	(1,271)
6	1,544	Matsushita Electric Industrial Co., Ltd.	(6)	(1,440)
7	1,434	Sony Corporation	(7)	(1,363)
8	1,416	General Electric Company	(13)	(1,107)
9	1,385	Hewlett-Packard Company **	(15)	(978)
10	1,373	Mitsubishi Denki Kabushiki Kaisha	(9)	(1,184)

\*The listed patent counts are preliminary counts. Final patent counts should be available in April 2003. This information reflects patent ownership at the time of patent grant and does not include ownership changes that occur after the patent grant. Where more than one assignee (owner) exists, patents are attributed to the first named assignee.

\*\* Calendar year counts for 2002 for Hewlett-Packard Company include 159 patents issued to Compaq Corporation, Inc. and 165 patents issued to Compaq Information Technologies Group, L.P.


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**Press Releases > USPTO Releases Annual List of Top 10 Organizations Receiving Most U.S. Patents**
**PRESS RELEASE**
**January 12, 2004**  
**#04-01**

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**USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST U.S. PATENTS**  
*The U.S. Again Leads the Way*

The Department of Commerce's United States Patent and Trademark Office (USPTO) today announced the 2003 private sector patent recipients. Listed below are the 10 corporations receiving the most U.S. patents for inventions in 2003, along with their 2002 ranking. For the 11th consecutive year, IBM was number one, receiving 3,415 patents—more than any other private sector organization, and 70% more than the next highest patent holder.

In 2003, the U.S. companies included on the list of top 10 patenting organizations are International Business Machines Corporation (first), Hewlett-Packard Company (fifth), Micron Technology, Inc. (sixth), and Intel Corporation (seventh). This year marks the first time Intel Corporation appears on the top 10 list. Intel Corporation increased its number of patents 48 percent over 2002. Hewlett-Packard Company increased its patent grants 27 percent over its 2002 count.

"The 2003 patent counts show American technological influence continuing to grow," noted Jon Dudas, Acting Under Secretary for Commerce for Intellectual Property. "Patents protect intellectual endeavors and encourage technological progress in industries that create jobs for Americans."

The U.S. Government received 879 utility patents for the year, which would rank it 17th among the top patenting organizations in 2003.

**Top 10 Private Sector Patent Recipients for the 2003 Calendar Year**

Preliminary Rank in 2003*	Preliminary # Patents in 2003*	Organization*	(Final Rank in 2002)	(Final Patent Count)
1	3,415	International Business Machines Corporation	(1)	2,565
2	1,992	Canon Kabushiki Kaisha	(2)	1,565
3	1,893	Hitachi, Ltd.	(5)	1,465
4	1,786	Matsushita Electric Industrial Co., Ltd.	(6)	1,465
5	1,759	Hewlett-Packard Development Company, L.P.	(9)	1,365
6	1,707	Micron Technology, Inc.	(3)	1,365
7	1,592	Intel Corporation	(15)	1,165
8	1,353	Koninklijke Philips Electronics N.V.	(16)	1,165
9	1,313	Samsung Electronics Co., Ltd.	(11)	1,165
10	1,311	Sony Corporation	(7)	1,165
	879	U.S. GOVERNMENT		

\*The patent counts are preliminary and are subject to correction. The final listing of patent counts for the top patenting organizations in 2003 will be available in the *Patenting By Organizations* report that should be available in early April.

# # #

**USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST U.S. PATENTS***American Innovation Continues to Top the Field*

The Department of Commerce's United States Patent and Trademark Office (USPTO) announced today the 2004 top 10 private sector patent recipients. Listed below are the 10 corporations receiving the most patents for inventions in 2004, along with their 2003 ranking. For the twelfth consecutive year, IBM received more patents than any other private sector organization.

"American innovation and discoveries are the foundation of our technological strength worldwide," said Jon Dudas, Under Secretary of Commerce for Intellectual Property. "Increasingly, patents have become an essential ingredient of our economic vitality, paving the way for investment in commerce and in research and development, and creating jobs for millions of Americans."

**Top 10 Private Sector Patent Recipients for 2004**

Preliminary Rank in 2004 *	Preliminary Number of Patents in 2004 *	Organization *	(Final Rank in 2003)	(Final Number of Patents in 2003)
1	3,248	International Business Machines Corporation	(1)	(3,415)
2	1,934	Matsushita Electric Industrial Co., Ltd. **	(4)	(1,774) **
3	1,805	Canon Kabushiki Kaisha	(2)	(1,992)
4	1,775	Hewlett-Packard Development Company, L.P. ***	(5)	(1,759) ***
5	1,760	Micron Technology, Inc.	(6)	(1,707)
6	1,604	Samsung Electronics Co., Ltd.	(9)	(1,313)
7	1,601	Intel Corporation	(7)	(1,592)
8	1,514	Hitachi, Ltd	(3)	(1,893)
9	1,310	Toshiba Corporation	(13)	(1,184)
10	1,305	Sony Corporation	(10)	(1,311)
	829	U. S. GOVERNMENT		(881)

\* The listed patent counts are preliminary and are subject to correction. The final listing of patent counts for the top patenting organizations in 2004 will be available in the *Patenting By Organizations* report that should be available in April.

\*\* Displayed calendar year counts for 2003 for *Matsushita Electric Industrial Co., Ltd.* include 12 patents issued to *Matsushita Electronics Corporation*, which has been merged into the parent company.

\*\*\* Displayed calendar year counts for 2003 for *Hewlett-Packard Development Company, L.P.* include 403 patents issued to *Hewlett-Packard Company*, 23 patents issued to *Compaq Computer Corporation, Inc.*, and 41 patents issued to *Compaq Information Technologies Group, L.P.*

Unless noted, no attempt has been made to combine data based on subsidiary relationships. However, where possible, spelling variations and variations based on name changes have been merged into a single name (e.g., ESSO to EXXON). While every effort is made to accurately identify all organizational entities and to report data by a single organization name, achievement of a totally clean record is not expected, particularly in view of the many variations that occur in corporate identifications.

(11Jan2005)